

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Thomas Daley, *et. al.*

Application No: 10/766,965

Filed: January 29, 2004

For: SYSTEMS AND METHODS FOR AVOIDING
TRANSACTION COSTS ASSOCIATED WITH TRADING
ORDERS

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Art Unit: 3696

Confirmation No.: 4387

Examiner: Gerald C. Vizvary

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 12-15, 17, 18, 21, 22 and 34-49 are pending in this application, of which claims 12, 34 and 42 are the independent claims.

I. Claim 12 is not indefinite, because “a length of time” is defined in the specification

The Examiner rejected claim 12 on the grounds that the term “a length of time” is indefinite. Final Action, p. 2. The Examiner is wrong.

The specification expressly defines “a length of time” as a pre-determined amount of time in which a market center will process a trading order before charging a transaction cost. Specification, para. 70. For example, paragraph 70 of the specification states the following:

Time threshold 34 specifies a length of time that is a predetermined amount of time, also referred to as buffer time, less than the length of time a particular market center 18 will process a trading order 20 before charging a transaction cost. For example, if a market center 18 charges a transaction cost for maintaining a trading order 20 active in its order book beyond five minutes, then cost avoidance module 40 may determine a timeout when the trading order 20 has been active for four minutes and fifty seconds. Id.

Therefore, the Examiner has failed to establish a *prima facie* case of indefiniteness for independent claim 12. For at least this reason, claim 12 (and the claims that depend therefrom) are definite and allowable for at least this reason.

II. Claim 15 is not indefinite, because “a length of time” is defined in the claim

The Examiner rejected claim 15 on the grounds that the term “a length of time” is indefinite. Final Action, p. 2. The Examiner is wrong.

Claim 15 recites, *inter alia*, “using a timer to measure a length of time that the first order is active within the market center” (emphasis added). The language of claim 15 clearly defines “a length of time” as the amount of time in which “the first order is active within the market center.”

Therefore, the Examiner has failed to establish a *prima facie* case of indefiniteness for claim 15.

III. Clear error in the rejection of claims 34-49 under 35 U.S.C. §112, para. 12

a. *Examiner fails to provide any explanation for why claims 34-49 are indefinite.*

In rejecting claims 34-49, the Examiner merely states the following:

Claims 34-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Final Action, p. 3.

No explanation is provided to explain why the Examiner considered these sixteen claims indefinite. Since it is impossible to ascertain the basis for the Examiner’s rejection, Applicants are unable to provide an adequate response. The Examiner’s failure to provide an adequate rejection of claims 34-49 results in a failure to make a *prima facie* case of obviousness for claims 34-49.

b. Claim 34-49 are properly written as referential claims, which are not indefinite.

Applicants assume, *arguendo*, that the Examiner rejected claims 34-49 using the same argument that he used when objecting to the same claims under 37 C.F.R. 1.75(c), as being of improper dependent form for “failing to further limit the subject matter of a previous claim.” Final Action, p. 2.

Claims 34-49 are written in a format similar to that of a product-by-process claim-- a claim for a product that contains a reference to a method claim. The claims are merely written in simplified form for the convenience of the Examiner.

The language of claims 34-49 makes it clear that claims 34-41 and 42-49 are, respectively, apparatus and article of manufacture claims which refer to a method claim. For example, each of claims 34-41 begins by reciting “an apparatus” and contains a clear reference to only the claimed “apparatus,” so that there is no confusion, whatsoever, that the claim might be a method claim, or anything other than an apparatus claim. Thus, each apparatus of claims 34-41 is capable of performing the method step(s) that it references.

For example, independent claim 34 (if not written in simplified form) would recite the following:

34. An apparatus comprising:
a processor; and
a memory, in which the memory stores instructions which, when executed by the processor, direct the processor to perform the method of:
receiving information about a first order, in which the information includes:
at least one parameter of the first order; an identity of a market center to which the first order is to be routed; an indication that the market center charges a transaction cost for orders that are processed after a length of time;
assigning a time threshold to the first order, in which the time threshold comprises the length of time of the market center less a pre-determined amount of time;
determining that the first order has not been processed before the time threshold;
transmitting an instruction to cancel the first order;
generating a second order, in which the second order comprises the at least one parameter of the first order; and
routing the second order to the market center.

Clearly, independent claim 34 is a definite and valid claim. It would be beyond argument that the person having ordinary skill in the art would be able to understand this above-cited claim construction, but not the present claim construction of claim 34. Dependent claims 35-41, which depend from claim 34, further limit the subject matter of the previous claim.

Likewise, each of claims 42-49 begins by reciting “an article of manufacture” and contains a clear reference to only the claimed “article of manufacture,” so that there is no confusion, whatsoever, that the claim might be a method claim or anything other than an article of manufacture claim. Thus, each article of manufacture of claims 42-49 is capable of performing the method step(s) that it references.

For example, independent claim 42 (if not written in simplified form) would recite the following:

42. An article of manufacture comprising:
a storage medium, in which the storage medium stores instructions which, when executed by a processor, direct the processor to perform the method of:
receiving information about a first order, in which the information includes:
at least one parameter of the first order; an identity of a market center to which the first order is to be routed; an indication that the market center charges a transaction cost for orders that are processed after a length of time;
assigning a time threshold to the first order, in which the time threshold comprises the length of time of the market center less a pre-determined amount of time;
determining that the first order has not been processed before the time threshold;
transmitting an instruction to cancel the first order;
generating a second order, in which the second order comprises the at least one parameter of the first order; and
routing the second order to the market center.

Again, there is little debate as to the definiteness and validity of claim 42. It would be beyond argument that the person having ordinary skill in the art would be able to understand this above-cited claim construction, but not the present claim construction of claim 42. Dependent claims 43-49, which depend from independent claim 42, further limit the subject matter of the previous claim.

Therefore, the Examiner has failed to establish a *prima facie* case of indefiniteness for claims 34-49.

IV. Conclusion

Because the Examiner failed to establish a *prima facie* case of indefiniteness with respect to claims 12-15, 17, 18, 21, 22 and 34-49, withdrawal of the rejections is respectfully requested.

Respectfully submitted,

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